UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,686	03/10/2000	Takaaki Nagae	1046.1211/JDH	5906

21171	7590	02/26/2004

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
HILLERY, NATHAN

ART UNIT	PAPER NUMBER
2176	7

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2003*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-9,12-17 and 20-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-9,12-17 and 20-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 March 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☒ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed on 12/12/03.

2.   Claims 1, 4 – 9, 12 – 17 and 20 – 24 are pending in the case. Claims 1, 9, and 17

independent.

3.   The rejections under 35 USC 112, second paragraph, of claims 6, 9 – 24 are

withdrawn in view of the new ground(s) of rejection.

4.   The rejections under 35 USC 103(a) have been withdrawn as necessitated by

amendment.

Priority

5.   Acknowledgment is made of applicant's claim for foreign priority based on an

application filed in Japan on 8/30/99. It is noted, however, that applicant has not filed a

certified copy of the 11-243872 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

6.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

7.   Claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Jackson [SinaNet].

8.   **Regarding independent claims 1, 9, and 17,** Jackson teaches that *an internet*

company has developed a system that it claims can receive and read Chinese-language

e-mail (lines 1 – 2), which provide for **receiving a sentence serving as the contents**

of an electronic mail. Jackson also teaches that *SinaNet has two coding standards for*

translating the characters, known as Big-5 for traditional and GB for simplified. A Big-5

user cannot read text generated by someone using GB and vice versa ... SinaNet's

SinaXpress application has modules that translate between Big-5 and GB and make

either format into a .GIF file for display on English-language browsers (lines 23 – 28),

which provide for **forming image data of the sentence when it is judged that the**

sentence is not text-displayable based on the text data on the basis of the

character code system at the destination; and transmitting the electronic mail

including the formed image data to the destination of the electronic mail. Jackson

does not explicitly teach **judging whether the sentence is text-displayable based on**

text data on the basis of a character code system used at a destination of the

electronic mail including the sentence. However, it would have been obvious to one

of ordinary skill in the art at the time of the invention to be motivated to judge the

sentence so that the invention disclosed by Jackson would transmit as little data as

possible over the web for those users with slow connections and limited memory.

9.   **Regarding dependent claims 4, 12, and 20**, Jackson teaches that *SinaNet has*

two coding standards for translating the characters, known as Big-5 for traditional and

GB for simplified. A Big-5 user cannot read text generated by someone using GB and

vice versa ... SinaNet's SinaXpress application has modules that translate between Big-

5 and GB and make either format into a .GIF file for display on English-language

browsers (lines 23 – 28), which provide for **displaying the sentence on a screen**

using text data of the sentence wherein, in the forming image data, image data

corresponding to the sentence written in a format displayed on the screen is

formed.

10.   **Regarding dependent claims 8, 16, and 24,** Jackson does not explicitly teach
that **the image data is transmitted as an attached file to the destination of the
electronic mail**. However, it would have been obvious to one of ordinary skill in the art
at the time of the invention to know that most Web e-mail services have the capability to
attach any file to an e-mail message.

11.   Claims 5 – 7, 13 – 15, and 21 – 23 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Jackson (SinaNet) as applied to claims 1, 4, 8, 9, 12, 16, 17, 20, and
24 above, and further in view of Flanagan et al. [US005966685A].

12.   **Regarding dependent claims 5, 13, and 21,** Jackson does not explicitly teach
**translating the sentence into a language used in the destination when the
sentence is expressed by characters written in a language different from the
language used in the destination of the electronic mail, wherein translation
results are transmitted to the destination of the electronic mail**. However, Flanagan
et al. do teach that *the present invention is a system of parallel discussion groups
operated in conjunction with a message collection/posting software program, data filter
software program, and a machine translation software program* (Column 2, lines 21 –
24) and that *some of the messages on a French version of a discussion group will have
been originally written in French whereas many will be translations of messages which
were originally written in a different language. Each of the messages translated from
another language version of the parallel discussion group may contain both the
translated message and the original language text. For example, a message originally*

written in the English version of the discussion group and translated to the French

version may be shown on screen with the original English text in addition to the French

translation (Column 3, lines 3 – 13). It would have been obvious to one of ordinary skill

in the art at the time of the invention to combine the inventions disclosed by Jackson

and Flanagan et al. because such a combination would allow the users of SinaNet

(Jackson) access to *machine translators and other software incorporated to translate*

messages, thereby creating parallel discussion groups in different languages (Abstract).

13.   **Regarding dependent claims 6, 14, and 22,** the claims incorporate

substantially similar subject matter as claims 1, 5, 9, 13, 17, and 21, and are rejected

along the same rationale.

14.   **Regarding dependent claims 7, 15, and 23,** Jackson teaches that *SinaNet has*

two coding standards for translating the characters, known as Big-5 for traditional and

GB for simplified. A Big-5 user cannot read text generated by someone using GB and

vice versa ... SinaNet's SinaXpress application has modules that translate between Big-

5 and GB and make either format into a .GIF file for display on English-language

browsers (lines 23 – 28), and Flannagan et al. teach that *some of the messages on a*

French version of a discussion group will have been originally written in French whereas

many will be translations of messages which were originally written in a different

language. Each of the messages translated from another language version of the

parallel discussion group may contain both the translated message and the original

language text. For example, a message originally written in the English version of the

discussion group and translated to the French version may be shown on screen with the

original English text in addition to the French translation (Column 3, lines 3 – 13), which

provide for **in the forming image data, translated image data of the translation

results expressed by characters written in the language used in the destination is

formed when it is determined that the characters are not written in the text-

displayable language used in the destination of the electronic mail, and the

electronic mail transmission method further comprises forming synthesized

image data obtained by combining the formed image data corresponding to the

sentence with the translated image data, and in the transmitting, the synthesized

image data is transmitted to the destination of the electronic mail**. It would have

been obvious to one of ordinary skill in the art at the time of the invention to combine the

inventions disclosed by Jackson and Flanagan et al. because such a combination would

allow the users of SinaNet (Jackson) access to *machine translators and other software

incorporated to translate messages, thereby creating parallel discussion groups in

different languages* (Abstract).

Response to Arguments

15.   Applicant's arguments with respect to claims 1, 9, and 17 have been considered

but are moot in view of the new ground(s) of rejection.

Conclusion

16.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nathan Hillery whose telephone number is (703) 305-

4502. The examiner can normally be reached on M - F, 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

NH

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER